

REMARKS

Amendments to the Claims:

Claim 40 has been amended to include at least one limitation of claim 42. Support for the amendments to claim 40 is found in claim 42, as well as in the specification at page 14, line 11 through page 15, line 9.

Each of claims 41, 42, and 43 depend from claim 40, and each has been amended to delete redundant limitations and to be consistent with the amendments to claim 40.

Claim 48 has been amended to include at least one limitation of claim 49. Support for the amendments to claim 48 is found in claim 49.

Claim 49 has been amended to eliminate redundant limitations and to be consistent with the amendments to claim 48.

Claim 51 has been amended to correct a typographical error as is explained in greater detail herein below.

Rejection of Claims Under 35 U.S.C. § 112:

Each of claims 8, 9, 11, and 38-54 (all of the pending claims) has been rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Specifically, the examiner states that "the limitation defining the elongated slot and a direction 'substantially transverse relative to the elongated slot' is confusing as it is not previously defined in a structural relationship with the roller, i.e. across the circumferential width of the roller," and that, "it is unclear what is meant by the limitations regarding the anvil as 'withdrawn from the slot' and 'exposed within the slot,'" and that, "the limitations 'an elongated slot defined by the roller' and 'knife defined by an edge' are unclear and indefinite". (Office action, page 2, section 3.) The examiner also states that "while features of an apparatus may be recited either structurally or functionally, claims directed towards an apparatus must be distinguished from the prior art in terms of structure rather than function". (Office action, page 4, section 8.) The examiner cites *In re Schreiber*, 128 F.3d 1473-78, 44 USPQ2d 1429-32 (Fed.Cir. 1997) and *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed.Cir. 1990).

1 The applicant respectfully disagrees with each of the examiner's contentions
2 set forth in section 3 of the office action.

3 An applicant can define in the claims what he regards as his invention
4 essentially in whatever terms he chooses so long as the terms are not used in ways
5 that are contrary to accepted meanings in the art, and an applicant may use
6 functional language, alternative expressions, negative limitations, or any style of
7 expression or format of claim which makes clear the boundaries of the subject matter
8 for which protection is sought. (MPEP 2173.01.) Additionally, there is nothing
9 inherently wrong with defining some part of the invention in functional terms. (MPEP
10 2173.05(g).) Functional language does not, in and of itself, render a claim improper.
11 (Id.) A functional limitation must be evaluated and considered, just like any other
12 limitation of the claim, for what it fairly conveys to a person of ordinary skill in the
13 pertinent art in the context in which it is used. (Id.) A functional limitation is often
14 used in association with an element to define a particular capability or purpose that is
15 served by the recited element. (Id.)

16 Moreover, acceptability of the claim language depends on whether one of
17 ordinary skill in the art would understand what is claimed, in light of the specification.
18 (MPEP 2173.05(b).) In other words, definiteness of claim language must be
19 analyzed in light of the claim interpretation that would be given by one possessing
20 the ordinary level of skill in the pertinent art at the time the invention was made.
21 (MPEP 2173.02.)

22 In regard to the limitation "an elongated slot defined by the roller", the
23 applicant notes that the specification explains that the "roller has an elongated slot
24 formed therein along at least a portion of the length parallel to axis of roller, and the
25 slot opens to the outer surface of roller". (Specification, page 4, lines 17-18.) Figure
5A also depicts the roller 122 and the slot 154 formed in the roller body 152 along a
substantial portion of the length "L" of the roller. Additionally, figures 5A, 5B, 6A, 6B,
7, and 8 show how the knife 156, 256 is held within the roller 122, 124, 224, and can
be movable to extend through the slot 154, 254.

The applicant contends that the depiction of the slot in the figures along with
the description of the slot in the specification enables one of ordinary skill in the art to
understand the limitation "an elongated slot defined by the roller" and to also
understand what is being claimed. The applicant therefore contends that the

1 limitation "an elongated slot defined by the roller" is neither unclear nor indefinite,
2 and that none of the claims containing that limitation is unclear or indefinite.

3 In regard to the limitation "knife defined by an edge" the applicant notes that
4 the specification explains that "a knife, defined by an edge, is received within the
5 elongated slot in the roller ... is configured to operably move from a first position
6 wherein the edge of the knife is retracted away from the surface of the roller, to a
7 second position wherein the edge of the knife protrudes outwardly from the surface
8 of the roller ... [to] thereby contact a sheet of media moving along the media path to
9 thereby either crease or cut the sheet". (Specification, page 4, lines 18-24.) Each of
10 figures 5A, 5B, and 7 depict a knife 156 defined by the edge 158. The knife 156 and
11 respective edge 158 is further explained in the specification at least at page 11, lines
12 11-23.

13 Moreover, the applicant submits that a knife is not a knife but for being
14 defined by an edge. That is, a knife, without having an edge, is not a knife.
15 Therefore, a knife must be defined by an edge as is explained in the specification
16 and as is recited in one or more of the applicant's claims. The applicant contends
17 that this, along with the depiction of the knife in the figures and the description of the
18 knife in the specification, shows that one of ordinary skill in the art could easily
19 understand the limitation "a knife defined by an edge" and could also easily
20 understand what is being claimed. The applicant therefore contends that the
21 limitation "a knife defined by its edge" is neither unclear nor indefinite, and that none
22 of the claims containing that limitation is unclear or indefinite.

23 In regard to the limitations "a direction substantially transverse relative to the
24 elongated slot" and "withdrawn from the slot" and "exposed within the slot", the
25 applicant contends that these limitations are exceedingly clear and unambiguous,
especially in light of the specification and drawings. For example, figure 8 shows the
roller 224, the slot 254 defined by the roller, the knife 256, and the anvils 266 and
268. The specification, at page 14, line 11 through page 15, line 9, with reference to
figure 8, explains and/or shows that the anvils 266 and 268 can be selectively moved
in direction "C" from a first position away from the slot 254 to a second position within
the elongated slot. The specification explains and/or shows further that when the
anvil 266, 268 is in the first position the knife 256 can be extended or deployed so as

1 to protrude through the slot 254, and that when the anvil is in the second position a
2 knife from an opposing roller can contact the anvil to cut or crease a sheet of paper.

3 In view of the fact that the word "transverse" is generally accepted to include
4 "across" or "crosswise" (American Heritage Dictionary of the English Language,
5 Third Ed.), it is clear that the direction "C" (shown in Fig. 8) can accurately be
6 described as transverse to the slot 254. Furthermore, it is clear that the anvil is
7 withdrawn from the slot when in the first position (as depicted in Fig. 8), and is
8 exposed within the slot when moved in direction "C" to the second position.

9 Accordingly, the applicant contends that the limitation "a cutting anvil operably
10 moveable along a path substantially transverse relative to the elongated slot from a
11 first position in which the cutting anvil is withdrawn from the slot to a second position
12 in which the anvil is exposed within the slot", as is contained in claim 1, is
13 exceedingly clear, completely unambiguous, and easily understood, especially by
14 one of ordinary skill in the art.

15 As mentioned above, the examiner contends that both *Schreiber* and *Hewlett-*
16 *Packard Co.* contain rulings that claims directed toward an apparatus must be
17 distinguished from the prior art in terms of structure rather than function.

18 The applicant respectfully disagrees. The applicant notes that *Schreiber*, at
19 the place cited by the examiner, quotes *In re Swinehart* (439 F.2d 210, 212, 169
20 USPQ 226, 228 (CCPA 1971)) when stating the following:

21 There is nothing intrinsically wrong with defining something by what it
22 does rather than what it is in drafting patent claims [However]
23 where the Patent Office has reason to believe that a functional
24 limitation asserted to be critical for establishing novelty in the claimed
25 subject matter may, in fact, be an inherent characteristic of the prior
art, it possesses the authority to require the applicant to prove that the
subject matter shown to be in the prior art does not possess the
characteristics relied upon.

Thus, the court in *Schreiber* does not rule that claims directed to an apparatus
be distinguished from the prior art in terms of structure rather than function, as the
examiner asserts. Rather, the holding of *Schreiber* is that functional limitations are
perfectly acceptable, but if a functional limitation is asserted to be critical for

1 establishing novelty, and if the Patent Office has reason to believe that the functional
2 limitation is an inherent characteristic of the prior art, then the Patent Office has the
3 authority to require the applicant to show that the prior art does not disclose the
4 functional limitation relied upon by the applicant.

5 Likewise, the court in *Hewlett-Packard Co.* does not rule that claims directed
6 toward an apparatus must be distinguished from the prior art in terms of structure
7 rather than function, as is asserted by the examiner.

8 Rather, the holding of *Hewlett-Packard Co.* is only that "... apparatus claims
9 cover what a device *is* not what a device *does*" and that "[a]n invention need not
10 *operate* differently than the prior art to be patentable, but need only *be* different".
11 (*Hewlett-Packard Co.*, 909 F.2d 1468, 15 USPQ2d ___, emphasis in the original.)

12 The applicant does not dispute the holding that apparatus claims cover what a
13 device is and not what a device does. However, the applicant asserts that this
14 holding does not infer or imply in any manner that claims directed toward an
15 apparatus must be distinguished from the prior art in terms of structure rather than
16 function, as the examiner contends.

17 The applicant reiterates that there is no requirement whatsoever that
18 structural limitations rather than functional limitations must be used to distinguish
19 claims from the prior art, as the examiner contends. The applicant notes further that
20 35 U.S.C. 112, second paragraph does not even require that a claim be
21 distinguishable from the prior art. That is, a claim can be completely anticipated by,
22 and/or obvious in view of, the prior art and still meet the requirements of 35 U.S.C.
23 112, second paragraph. Stated in another way, the only requirement stipulated by
24 35 U.S.C. 112, second paragraph is that the applicant particularly point out and
25 distinctly claim the subject matter which the applicant regards as the invention. The
applicant asserts that the applicant has, as explained above, particularly pointed out
and distinctly claimed the subject matter which the applicant regards as
the invention.

In regard to claim 51, the examiner has rejected that claim because the
limitation, "within the second roller" in line 2 of that claim does not have sufficient
antecedent basis. The applicant has amended claim 51 as indicated herein above
so that the limitation "within the second roller" now reads, "within the roller". The
applicant notes that the inclusion of the word "second" in the subject limitation was a

1 typographical error as is evidenced by the fact that only one roller is claimed. The
2 applicant contends that claim 51, as amended, now meets the requirements of 35
3 U.S.C. 112, second paragraph.

4 Thus, for at least the reasons set forth above, each of the applicant's claims
5 meet the requirements of 35 U.S.C. 112, second paragraph. Accordingly, the
6 applicant respectfully requests that the rejections of the claims under 35 U.S.C. 112,
7 second paragraph be withdrawn.

8 Rejection of Claims Under 35 U.S.C. § 102:

9 Each of claims 40, 46-48, 51, 52, and 54 has been rejected under 35 U.S.C.
10 102(b) as being anticipated by Chambers et al. (US 225,506).

11 As is generally accepted, a claim is anticipated only if each and every element
12 as set forth in the claim is found, either expressly or inherently described, in a single
13 prior art reference. (MPEP 2131.) Also, for a claim to be anticipated by a reference,
14 the identical invention must be shown in the reference in as complete detail as
15 contained in the claim. (Id.)

16 The applicant has amended claim 40 to now include the following limitations:

17 *an anvil device disposed within the roller and operably movable between an*
18 *exposed position in which the anvil device is in substantially juxtaposed registered*
19 *alignment with the slot and a withdrawn position in which the anvil device is not in*
20 *substantially juxtaposed registered alignment with the slot.*

21 The applicant contends that Chambers does not teach or disclose this
22 limitation. Rather, Chambers discloses, in figure 7, a roller (*l*) having a fixed (not
23 moveable) blade (*j*) mounted within a slot (*not referenced*). The applicant contends
24 that blade (*j*) is fixed because there is no disclosure, suggestion, or any other
25 evidence, either express or implied, tending to show that blade (*j*) is not fixed.
Chambers also discloses a groove (*h*) that may be in a bar made adjustable around
the periphery of the roller (*l*). (Chambers, second page of written description, lines
82-85.)

As is seen from a study of Fig. 7 of Chambers, the groove (*h*) cannot be
positioned so as to be in substantially juxtaposed registered alignment with the slot,
because the fixed blade (*j*) blocks such positioning. That is, the fixed blade (*j*)
located in the slot of Chambers prevents the positioning of the groove (*h*) in

1 substantially juxtaposed registered alignment with the slot, as is now required by the
2 applicant's claim 40.

3 Claim 40, as amended, is therefore not anticipated by Chambers because
4 each and every element as set forth in claim 40 is not found, either expressly or
5 inherently described, in Chambers, and because the identical invention is not shown
6 in as complete detail in Chambers as is contained in claim 40.

7 Accordingly, the applicant respectfully requests that the rejection of claim 40
8 under 35 U.S.C. 102 be withdrawn.

9 The applicant has amended claim 48 to now include the following limitations:

10 an anvil device disposed within the roller and operably movable along a path
11 substantially transverse relative to the elongated slot wherein the anvil device is
12 movable along the path between a first position in which the anvil device is
13 withdrawn from the slot to a second position in which the anvil device is exposed
14 within the slot.

15 The applicant contends that Chambers does not teach or disclose these
16 limitations. As is explained above, Chambers discloses, in figure 7, a roller (I) having
17 a fixed (not moveable) blade (j) mounted within a slot (not referenced) along with a
18 groove (h) that may be in a bar made adjustable around the periphery of the roller (I).

19 As is seen from a study of Fig. 7 of Chambers, the groove (h) cannot be
20 positioned so as to be exposed within the slot, because the fixed blade (j) is blocking
21 such positioning. That is, the fixed blade (j) located in the slot of Chambers prevents
22 the positioning of the groove (h) so as to be exposed within the slot, as is now
23 required by the applicant's claim 48.

24 Claim 48, as amended, is therefore not anticipated by Chambers because
25 each and every element as set forth in claim 48 is not found, either expressly or
inherently described, in Chambers, and because the identical invention is not shown
in as complete detail in Chambers as is contained in claim 48.

Accordingly, the applicant respectfully requests that the rejection of claim 48
under 35 U.S.C. 102 be withdrawn.

Each of claims 46 and 47 depend from claim 40. Thus, each of claims 46 and
47 includes the limitations required by claim 40, and each of claims 46 and 47 is
therefore not anticipated by Chambers for at least the reasons set forth above with
respect to the arguments against the anticipation of claim 40 by Chambers.

1 Accordingly, the applicant respectfully requests that the rejections of each of
2 claims 46 and 47 be withdrawn.

3 Each of claims 51, 52, and 54 depend from claim 48. Each of claims 51, 52,
4 and 54 thus includes the limitations required by claim 48, and each of claims 51, 52,
5 and 54 is therefore not anticipated by Chambers for at least the reasons set forth
6 above with respect to the arguments against the anticipation of claim 48
by Chambers.

7 Accordingly, the applicant respectfully requests that the rejections of each of
8 claims 51, 52, and 54 be withdrawn.

9 Rejection of Claims Under 35 U.S.C. § 103:

10 Each of claims 8, 9, 11, 38, 39, 41-45, 49, 50, and 53 has been rejected under
11 35 U.S.C. 103(a) as being unpatentable over Couturier (US 6,296,601) in view
12 of Chambers et al. (US 225,506).

13 The applicant notes that the examiner bears the initial burden of factually
14 supporting a *prima facie* conclusion of obviousness. (MPEP 2142.) A *prima facie*
15 case of obviousness requires, among other things, that the prior art reference (or
16 references when combined) must teach or suggest all the claim limitations. (Id.) If
the examiner does not produce a *prima facie* case, the applicant is under no
obligation to submit evidence of nonobviousness. (Id.)

17 The examiner has not produced a *prima facie* case of obviousness with
18 respect to claim 8. Specifically, the examiner has not alleged that the prior art
19 teaches or suggests all the limitations of claim 8, as is required for a *prima facie*
20 case. More specifically, the applicant's claim 8 includes the following limitations:

21 a second roller having an elongated slot formed therein and
22 a cutting anvil disposed within the second roller and operably moveable along
23 a path substantially transverse relative to the elongated slot from a first position in
24 which the cutting anvil is withdrawn from the slot to a second position in which the
25 anvil is exposed within the slot.

The examiner alleges that Couturier discloses no more than the following:

- 1) a media path;
- 2) a retractable knife received within the elongated slot of the first roller; and,

1 3) the knife is movable between a retracted position and a forming position
2 thereby creasing the sheet and forcing the end of the crease to the
3 elongated slot of the second roller and cutting anvils.

4 The examiner alleges that Chambers discloses no more than the following:

- 5 1) an anvil assembly movable between a position which exposes or blocks
6 the media path; and,
7 2) a knife.

8 The applicant again emphasizes that the examiner has not alleged that the
9 prior art teaches or suggests any more that the above listed elements.

10 Therefore, the examiner has not produced a *prima facie* case of obviousness
11 because the examiner has not established all of the requirements of a *prima facie*
12 case, which requirements include the requirement that the prior art references must
13 teach or suggest all the claim limitations. Again, the examiner has not alleged that
14 the prior art teaches or discloses the following limitations required by claim 8:

15 a second roller having an elongated slot formed therein and
16 a cutting anvil disposed within the second roller and operably moveable along
17 a path substantially transverse relative to the elongated slot from a first position in
18 which the cutting anvil is withdrawn from the slot to a second position in which the
19 anvil is exposed within the slot.

20 Thus a *prima facie* case has not been produced, and the applicant is therefore
21 under no obligation to submit evidence of nonobviousness.

22 However, notwithstanding the fact that a *prima facie* case of obviousness has
23 not been produced with respect to claim 8, the applicant contends that the prior art
24 does not teach or suggest a cutting anvil operably moveable along a path
25 substantially transverse relative to the elongated slot from a first position in which the
cutting anvil is withdrawn from the slot to a second position in which the anvil is
exposed within the slot, as is required by claim 8. Moreover, not only do neither of
the cited references teach or suggest these limitations of claim 8, but Chambers, as
is explained above with respect to the arguments against the rejections of claim 40
and 48, teaches away from this limitation required by claim 8. That is, Chambers
teaches that a fixed knife is disposed within the slot, thus preventing an anvil from
being positioned so as to be exposed within the slot. Thus, because the prior art

1 does not teach or suggest all the limitations of claim 8, claim 8 is therefore
2 nonobvious in view of the prior art.

3 Each of claims 9, 11, 38, and 39 depends from claim 8. Therefore, a *prima*
4 *facie* case of obvious has not been produced for each of claims 9, 11, 38, and 39 for
5 the reasons that a *prima facie* case of obviousness has not been produced for claim
6 8 as explained above. Also, each of claims 9, 11, 38, and 39 is nonobvious in view
7 of the prior art for the reasons that claim 8 is nonobvious in view of the prior art as
8 explained above.

9 Accordingly, for at least the reasons set forth above, the applicant respectfully
10 requests that the rejections of claims 8, 9, 11, 38, and 39 under 35 U.S.C. 103
11 be withdrawn.

12 Each of claims 41-45 depends from claim 40. Claim 40 has not been rejected
13 as being obvious in view of the prior art. Claim 40 is not anticipated by the prior art
14 for the reasons set forth herein above. Each of claims 49, 50, and 53 depends from
15 claim 48. Claim 48 has not been rejected as being obvious in view of the prior art.
16 Claim 48 is not anticipated by the prior art for the reasons set forth herein above.
17 The applicant notes that if an independent claim is nonobvious under 35 U.S.C. 103,
18 then any claim depending therefrom is nonobvious. Each of claims 41-45, 49, 50,
19 and 53 is nonobvious because each of those claims depend from a respective claim
20 that is both nonobvious and not anticipated by the prior art.

21 Accordingly, the applicant respectfully requests that the rejections of each of
22 claims 41-45, 49, 50, and 53 under 35 U.S.C. 103 be withdrawn.

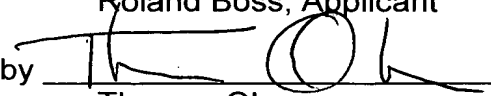
23 SUMMARY

24 The applicant believes that this communication constitutes a complete
25 response to the office action mailed 09/13/2005. Also, the applicant respectfully
requests allowance of claims 8, 9, 11, and 38-54.

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Response/Amendment